REMARKS

Claims 1 and 4-21 are presented for examination. Claims 1 and 4-11 are allowed.

Claims 12-17, 19 and 20 have been rejected under 35 U.S.C. 102(e) as being anticipated by Daines et al. Dependent claims 18 and 21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Daines et al. in view of Joung et al. Theses rejections are respectfully traversed for the following reasons.

Independent claim 12 recites a network interface device for providing an interface between a data network and a computer system, the network interface device comprising:

- a descriptor management unit for managing receive descriptors pointing to receive buffers allocated to receive data from the network medium, and

- an automatic flow control mechanism for automatically performing flow control in accordance with the number of available receive descriptors pointing to the receive buffers available for receiving data from the network medium.

Independent claim 19 recites a method of automatic flow control in a network interface between a data network and a computer system. The method comprises the steps of:

- monitoring the number of receive descriptors pointing to buffers in the computer system available for receiving data from the network, and

- automatically requesting a remote station in the data network to suspend data transmission when the number of receive descriptors falls below a first preprogrammed threshold level.

2

The Examiner relies upon col. 6, lines 58-62 for disclosing the claimed descriptor management unit.

The Examiner admits that Daines et al. "fails to disclose means wherein the buffers are specifically referred to by descriptors."

Further, the Examiner points out that "these features are well known in the art and it would have been an obvious modification of the system disclosed by Daines et al." (emphasis is added).

Accordingly, the Examiner considers the subject matter of claims 12 and 19 to be obvious over Daines et al. However, these claims were rejected under 35 U.S.C. 102 as being anticipated by Daines et al. Accordingly, the Examiner's rejection is improper.

It is noted that anticipation, under 35 U.S.C. § 102, requires that each element of a claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference. *Kalman v. Kimberly-Clark Corp.,* 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983); *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 9 USPQ2d 1920 (Fed. Cir. 1989) *cert. denied,* 110 S.Ct. 154 (1989). The term "anticipation," in the sense of 35 U.S.C. 102, has acquired the accepted definition meaning "the disclosure in the prior art of a thing substantially identical with the claimed invention." *In re Schaumann,* 572 F.2d 312, 197 USPQ 5 (CCPA 1978).

In the previous response, the Applicant demonstrated that Daines neither expressly nor inherently discloses the subject matter of claims 12 and 19.

In response, the Examiner takes the position that "the descriptors are inherent as defined by Microsoft Computer Dictionary." It is noted that the Examiner relies upon the definition of descriptors as "a piece of stored information used to describe something else..."

The Examiner asserts that "the fact that the flow control mechanism of Daines et al. can refer to specific buffers means that descriptors by this definition are being used."

The Examiner is reminded that to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probability or possibilities. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

As one skilled in the art would understand "the fact that the flow control mechanism of Daines et al. can refer to specific buffers" does not mean that the flow control mechanism of Daines et al. necessarily perform flow control in accordance with the number of available receive descriptors pointing to the receive buffers, as claim 12 requires, or necessarily monitors the number of receive descriptors pointing to buffers in the computer system available for receiving data from the network, and automatically requests a remote station in the data network to suspend data transmission when the number of receive descriptors falls below a first preprogrammed threshold level, as claim 19 requires.

Accordingly, the Examiner's own statement proves that his conclusion of anticipation is unwarranted.

Further, the Examiner argues against the Applicant's assertion that Daines et al. does not teach monitoring the number of receive descriptors pointing to buffers in the computer system available for receiving data from the network, as claim 19 requires.

The Examiner found this argument to be not persuasive because "the flow control mechanism of Daines et al. may manage a number of buffers and their availability (column 7, lines 5-10)."

It is respectfully submitted that one skilled in the art would understand that the ability of a system to manage a number of buffers does not necessarily means that this system monitors the number of receive descriptors pointing to the buffers.

Daines et al. discloses a flow control mechanism including a level indicator indicating the amount of data stored in the buffer. Preset high and low threshold levels define the maximum data level and a "restart" level (col. 6, line 58 to col. 7, line 4). The flow control device 25 monitors the level indicators for each buffer to determine if the amount of data stored therein exceeds a threshold level (col. 7, lines 6-9).

The reference provides no reason to conclude that the flow control device of Daines necessarily monitors the number of receive descriptors pointing to receive buffers, and

automatically performs flow control in accordance with the number of available receive descriptors pointing to the receive buffers, as claim 12 requires, or

automatically requests a remote station in the data network to suspend data transmission when the number of receive descriptors falls below a first preprogrammed threshold level, as claim 19 recites.

5

Hence, Daines neither expressly nor inherently discloses the subject matter of claims 12 and 19 even when descriptors are defined in accordance with the Examiner's interpretation. Dependent claims 13-18, 20 and 21 are defined over the prior art at least for the reasons presented above in connection with claims 1 and 12.
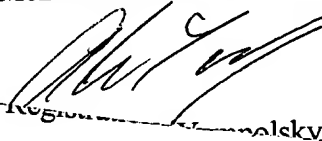
Therefore, Applicant respectfully submits that the rejections of claims 12-21 are untenable and should be withdrawn.

In view of the foregoing, and in summary, claims 1 and 4-21 are considered to be in condition for allowance. Favorable reconsideration of this application is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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